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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/987,040	11/13/2001	Craig Priest	13808RCE	6305
293 7590 01/06/2009 Ralph A. Dowell of DOWELL & DOWELL P.C. 2111 Eisenhower Ave Suite 406 Alexandria, VA 22314			EXAMINER BLAIR, DOUGLAS B	
			ART UNIT 2442	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

09/987,040

Applicant(s)

PRIEST ET AL.

Examiner

DOUGLAS B. BLAIR

Art Unit

2442

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-21, 23-25 and 27-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-21, 23-25 and 27-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/20/2008 has been entered.

Response to Arguments

Applicant's arguments filed 3/20/2008 have been fully considered but they are not persuasive. The applicant argues that the applicant's amendments have overcome the previous rejections. The Examiner does not agree.

With respect to claim 17, the claim does not state what has obtained an indicator or what is classifying a plurality of users. Given the broad nature of the applicant's claims, the previous rejection is maintained as it can be argued that Koester "obtains" and "classifies". The applicant's claims need to be amended to specifically point out how the applicant's message exchange server is performing each of these steps.

With respect to claims 23, 31, and 32, the claim amendment only uses the language "by way of said message exchange device". This language allows for any broad association with a message exchange device. Sutcliffe is considered to be used "by way of message exchange device".

With respect to claims 27 and 30, Suttcliffe teaches the paying users accessing "through a server" in Figure 1.

The applicant is encouraged to amend the claims to precisely claim the relationship between the applicant's process and the applicant's message exchange server in order to further prosecution.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 17-21, 23-25, and 31-34 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The applicant's claimed processes do not produce a tangible result relating to any machine or device. The preamble of the claims mention a device but the process as claimed has nothing to do with a device. The claimed process could be performed entirely within a persons mind. Such processes are not statutory.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this

subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 23-24, and 27-34 are rejected under 35 U.S.C. 102(a) and (e) as being anticipated by U.S. Patent Number 6,052,122 to Sutcliffe et al..
3. Sutcliffe teaches a method of operating a message exchange device (as in exemplary claim 23) comprising: storing greetings originating with each of a plurality of users using said message exchange device (col. 9, lines 25-48); obtaining from each of said plurality of users an indicator of whether that user wishes to pay to use said message exchange device, thereby classifying each of said plurality of users as a paying or non-paying user (col. 4, lines 9-10 and col. 6, lines 34-67, the “stamps” indicate whether or not a user has paid for service.); allowing paying users access to all of said stored greetings (col. 4, lines 9-10 and col. 6, lines 34-67); allowing non-paying users access to only those greetings originating with paying users (col. 4, lines 9-10 and col. 6, lines 34-67, user’s can only contact other users by using their “stamps”); calculating costs of using said message exchange device for each of said paying users based on time each of said paying users uses said message exchange device (col. 4, lines 9-10 and col. 6, lines 34-67, the stamps provide a measure of time in that a user that uses more stamps uses more time.).
4. The rest of the independent claims are also taught by Sutcliffe. Claim 27 features a message exchange server that performs a similar method to claim 23 and Sutcliffe teaches a message exchange server (Server 18 in Figure 1). Claim 30 features instructions for causing a message exchange server to perform the method of claim 23. Claim 31 features a similar method to claim 23. Claims 32 and 33 feature the same method as in claim 23.

5. As to claims 24 and 28, Sutcliffe teaches a method wherein greetings comprise voice messages and allowing paying users comprises allowing paying users to listen to all of the stored greetings (col. 9, lines 25-48).
6. As to claim 29, Sutcliffe teaches a server with memory that stores an amount representative of prepayment of users paying to use said server (col. 4, lines 9-10 and col. 6, lines 34-67).
7. As to claim 34, Sutcliffe teaches a method wherein measuring use of a device comprises measuring the number of greeting each paying user has accessed (col. 9, lines 24-48).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 17, 19, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,594,502 to Koester in view of U.S. Patent Number 6,052,122 to Sutcliffe et al..
10. As to claim 17, Koester teaches a method of operating a device providing a service allowing a plurality of users to communicate with each other by exchanging messages, comprising: for each of said plurality of users determining if said each of said plurality of users wishes to pay for use of said service (**col. 2, lines 61-64, the subscribing users who store information are considered the “paying users”**), and thereby identifying each of said users as

a paying user or a non-paying user (**col. 2, lines 64-67, the potential daters are considered the non-paying users. Note that the reference says the potential daters can be charged so that does not mean they have to be charged. For the purposes of this rejection the embodiment where the potential daters are not charged is being used to reject this claim**); allowing paying users to communicate with all of said plurality of users (**the subscribing users can communicate with anyone who contacts them**); restricting non-paying users from initiating communication with other non-paying users, while allowing non-paying users to initiate communication with paying users (**the potential daters can only initiate communications with the subscribing users**); however Koester does not explicitly teach calculating costs of said service for each of said playing users, based on time each of said paying users.

Sutcliffe teaches a method of operating a device providing a service allowing a plurality of users to communicate with each other by exchanging messages including calculating costs of said service for each of said playing users, based on time each of said paying users (**col. 4, lines 9-10 and col. 6, line 46, the stamps provide a measure of time in that a user that uses more stamps uses more time.**).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Koester regarding a dating system that does not allow non-paying users to contact other non-paying users while allowing paying users to communicate with all users with the teachings of Sutcliffe regarding payments based on a measured amount of time using the system because such a system allows a user to pay for only what they actually use.

11. As to claim 19, Koester teaches a method of permitting users to exchange messages in near real-time (**col. 2, lines 54-55, an instant message**).

12. As to claim 21, Koester teaches a method wherein the device comprises a telephone interface and a storage medium, wherein said method comprises exchanging saved messages between said users (**col. 2, lines 49-55, any of the message types read on the saved messages**).

13. Claims 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,594,502 to Koester in view of U.S. Patent Number 6,052,122 to Sutcliffe et al. in further view of U.S. Patent Number 6,865,161 to Sponaugle et al.

14. As to claim 18, the Koester-Sutcliffe makes the method of claim 17 obvious, however the Koester-Sutcliffe combination does not teach bridging a call between a plurality of users.

Sponaugle teaches a method of bridging a call between a plurality of users of message exchange device (col. 5, lines 8-44) in the context of a dating service (col. 8, lines 25-42).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the applicant's invention to combine the teachings of the Koester-Sutcliffe combination regarding the management of a message exchange system with the teachings of Sponaugle regarding the bridging of a telephone call because voice communication enhances a users ability to communicate.

15. As to claim 20, both the cited portions of the Koester, Sutcliffe, and Sponaugle references discuss collecting fees before providing services.

16. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,052,122 to Sutcliffe et al. in view of U.S. Patent Number 6,865,161 to Sponaugle et al..

17. As to claim 25, Sutcliffe teaches the method of claim 23, however Sutcliffe does not teach bridging a call between a plurality of users.

Sponaule teaches a method of bridging a call between a plurality of users of message exchange device (col. 5, lines 8-44) in the context of a dating service (col. 8, lines 25-42).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the applicant's invention to combine the teachings of Sutcliffe regarding the management of a message exchange system with the teachings of Sponaule regarding the bridging of a telephone call because voice communication enhances a users ability to communicate.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOUGLAS B. BLAIR whose telephone number is (571)272-3893. The examiner can normally be reached on 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Douglas B Blair/
Primary Examiner, Art Unit 2442